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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,114	05/06/2004	Heinfried Hoffmann	P04,0153	7271
26574	7590	12/31/2007		
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			EXAMINER BARAN, MARY C	
			ART UNIT 2857	PAPER NUMBER
			MAIL DATE 12/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/840,114

Applicant(s)

HOFFMANN ET AL.

Examiner

Mary C. Baran

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26-42 and 44-52 is/are allowed.
- 6) ☒ Claim(s) 53 is/are rejected.
- 7) ☒ Claim(s) 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to the Amendments filed 20 September 2007. Claims 26-53 are pending. Claims 1-25 are cancelled. Claims 26-53 are new.

Claim Objections

2. Claim 43 is objected to because of the following informalities: claim 43 line 1, "A method of claim 42" should be – A system of claim 42 –. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 53 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 53 recites both "a method to test operating safety of a process control device ... the method comprising", and "said process control device comprising", and therefore is considered ambiguous because it attempts to further limit a method with an apparatus, thereby incorporating both product and process subject matter.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 53 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 53 recites both "a method to test operating safety of a process control device ... the method comprising", and "said process control device comprising", and is not directed to either a "process" or a "machine" but rather overlaps two different statutory classes of inventions set forth in 35 U.S.C. 101.

Allowable Subject Matter

- Handwritten: 26-07*
5. Claims 26-5²₃ are allowed.

6. The following is an examiner's statement of reasons for allowance:

Claims 26-38 are allowable over the prior art because the combination of limitations which recite: a method for testing a safety system for closing or opening a pipe of a process system to bring the process system to a safe operating state in the event of an incident, said safety system comprising: a pneumatic actuator operating the control valve via a movable coupling element, said method comprising: providing a sensor which measures movement of said coupling element, and which provides a measurement value to said position controller; to test operational capability of said

safety system including said control unit, with the position controller generating a test signal and sending it via said signal connection to said control unit so that said control unit is operated to partially move said coupling element with said actuator is not found, taught or suggested in the prior art of record.

Claims 39-51 are allowable over the prior art because the combination of limitations which recite: a system, comprising: a safety system for closing or opening a pipe of a process system to bring a process system to a safe operating state in the event of an incident, said safety system comprising, a pneumatic actuator operating the control valve via a movable coupling element, and a testing system for testing operation of said safety system, comprising: a sensor which measures movement of said coupling element and which provides a measurement value to said position controller, and a position controller which generates a test signal to test operational capability of said safety system including said control unit and which has a test signal connection to said control unit by which said test signal is sent to operate said control unit to partially move said coupling element via said actuator is not found, taught or suggested in the prior art of record.

Claim 52 is allowable over the prior art because the combination of limitations which recite: a testing system for testing operation of a safety system for closing or opening a pipe of a process system to bring a process system to a safe operating state in the event of an incident, said safety system comprising a pneumatic actuator operating the control valve via a movable coupling element, said testing system comprising: a sensor which measures movement of said coupling element and which

provides a measurement value to said position controller; and a position controller which generates a test signal to test operational capability of said safety system including said control unit by which said test signal is sent to operate said control unit to partially move said coupling element via said actuator is not found, taught or suggested in the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary C. Baran whose telephone number is (571) 272-2211. The examiner can normally be reached on Monday to Friday 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eliseo Ramos-Feliciano can be reached on (571) 272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mary Catherine Baran
21 December 2007

Hal Wachsmann
HAL WACHSMAN
PRIMARY EXAMINER
4/28/07